

Remarks/Arguments

The present submission is made in accordance with 37 C.F.R. § 1.114 in conjunction with Applicant Request for Continued Examination. Claim 1-4, 6-12, and 14 remain pending in the application.

In the Action, the Examiner rejected the claims for the reasons previously set forth in Paper No. 6. More particularly, claim 1 was rejected under 35 U.S.C. § 101 as anticipated by U.S. Patent No. 4,902,445 to Bjorhaag et al. ("*Bjorhaag*"). Claims 1-4 were rejected under 35 U.S.C. § 103(a) as obvious over EP0222720A to Kallstrom ("*Kallstrom*") in view of *Bjorhaag*. Claim 6 was rejected under 35 U.S.C. § 103(a) over *Kallstrom* in view of *Bjorhaag* in further view of U.S. Patent No. 4,037,650 to Randall ("*Randall*"). Claim 7 was rejected under 35 U.S.C. § 103(a) as obvious over *Bjorhaag* in view of U.S. Patent No. 4,409,107 to Sugano ("*Sugano*"). Claims 8 and 9 were rejected under 35 U.S.C. § 103(a) as obvious over *Bjorhaag* in view of *Sugano* in further view of U.S. Patent No. 3,981,831 to Markusch ("*Markusch*"). Claims 7-12 were rejected under 35 U.S.C. § 103(a) as obvious over *Kallstrom*, *Bjorhaag*, *Sugano*, and *Markusch*. Claim 14 was rejected under 35 U.S.C. § 103(a) as obvious over *Kallstrom*, *Bjorhaag*, *Sugano*, and *Markusch* in further view of *Randall*.

With regard to the rejection of claim 1, the Examiner deemed the arguments distinguishing *Bjorhaag* as unpersuasive because Applicant was relying on an unclaimed limitation, *i.e.*, a **hydrophilic** wicking agent. Claim 1 has been amended to clarify that the claimed invention includes "an agent for binding free water." As Applicant pointed out in its Amendment dated February 25, 2003, *Bjorhaag* discloses the use of a **hydrophobic** sealant that **repels** water. Such a compound is undesirable and ineffective in the present invention, which calls for a binding agent to remove free water from the claimed compound, thereby creating a

dry material that can be formed into the claimed fire protective container wall. The sealant disclosed in *Bjorhaag* does not bind water – it repels water. The use of a water repellant is clearly at odds with and cannot be construed to anticipate the claimed “agent for binding free water.” Since claims 2-3 and 6 depend from claim 1, they are also believed to be patentable.

With regard to the rejection of claim 6 in view of *Kallstrom*, *Bjorhaag* and *Randall*, the Examiner has misconstrued Applicant’s remarks from the February 25, 2003, amendment and misapplied the requirements for a *prima facie* obviousness rejection. In particular, Applicant did not rely on limitations not stated in the claims. Instead, Applicant first traversed the section 103 rejection on the basis that *Randall* fails to disclose a composition that can form the claimed phase change wall. This is not an unclaimed limitation, as claim 6 specifically recites “an ***inner wall*** composed of a phase change material . . . wherein said phase change material is composed of dibasic and tribasic sodium phosphate, and water.” It is inherent that the claimed phase change material would need to be in solid form at least part of the time in order for it to (1) be a phase change material in the first place, and (2) be capable of forming a wall. *Randall* only discloses an ***aqueous solution*** that is useful as a liquid bath for a heat storage device in a home heating and cooling system. *Randall* thus does not disclose anything capable of forming the claimed ***phase change wall***.

Applicant also traversed the section 103 rejection on the basis that *Randall* does not motivate or suggest the use of such a solution to form a wall in a fire protection container, as required for a *prima facie* obviousness rejection. See MPEP § 2142. As *Randall* is limited to an aqueous solution in an air conditioning system, the reference cannot provide the requisite motivation or suggestion to use the aqueous compound as a solid phase change wall in a fire protective container. Applicant has not relied on any unclaimed limitations as suggested by the

Examiner; rather, Applicant merely pointed out *Randall* fails to teach, motivate, or suggest the elements that are indeed recited in the fire protection container of claim 6.

The Examiner also suggested that Applicant cannot distinguish *Randall* based of its use as an aqueous solution for a different purpose. While this argument might be accurate with regard to an anticipation rejection under 35 U.S.C. § 102, it is not necessarily applicable to an obviousness rejection under 35 U.S.C. § 103(a). When making an obviousness rejection, the Examiner has a duty to explain why the combination is proper by pointing to a suggestion or motivation for making the proposed combination. *See* MPEP § 2142. As *Randall* does not suggest or motivate using the disclosed solution in a wall for any purpose, including heat resistance (it only teaches the use of the solution for an entirely different use and in connection with different structure), it does not provide the motivation or suggestion required for a rejection under section 103.

With regard to the rejection of claim 7, the Examiner did not agree with the Applicant that *Sugano* is non-analogous art, finding that the reference was directed to “water glass” compositions. *Sugano* is, in fact, entirely non-analogous art. *Sugano* is strictly concerned with an improved process for manufacturing *sodium percarbonate*, a well-known peroxide bleach that is not a “water glass” composition. Indeed, sodium percarbonate is not even a silicate. Thus, *Sugano* is not in the “water glass” art, as suggested by the Examiner, and is directed toward a completely different class of compounds than water glass compositions. Moreover, *Sugano* is not concerned with any of the problems faced by the present applicant, nor is the reference directed toward a similar solution. *See* MPEP § 2141.01(a). As a result, *Sugano* does not qualify as an analogous reference that can support an obviousness rejection under section 103.

In addition to the argument that *Sugano* was non-analogous art, Applicant also traversed the section 103 rejection on the basis that the proposed motivation identified by the Examiner in *Sugano* was, in fact, an erroneous interpretation of that reference. The Examiner did not address Applicant's point, however, and continued the section 103 rejection based on the erroneous finding in *Sugano* that sodium phosphate improves storage stability. As fully explained by Applicant, *Sugano* teaches the use of an **organic chelating agent** to improve stability of the final product, not sodium phosphate. *See Sugano*, col. 2, ll. 36-41 ("a stabilizer of an organic chelating type"); *see also* col. 3, ll. 1-27 (describing chelating agents in detail). Thus, there is no motivation or suggestion to use sodium phosphate in the present invention as a stabilizer and the section 103 rejection must fail.

With regard to the rejection of claims 8 and 9, the Applicant explained in detail how at least one claim element, calcium metasilicate, was not disclosed by **any** of the references, including the one relied on by the Examiner. As a result, the obviousness rejection is plainly improper. MPEP § 2143.03. As the references do not even disclose the compound, they certainly cannot motivate or suggest the use of calcium metasilicate in the claimed invention as required for a rejection under section 103. The Examiner failed to address the Applicant's showing that calcium metasilicate was missing from the proposed combination of references and did not identify how the use of calcium metasilicate was motivated or suggested by the prior art. *See* MPEP 2142 ("When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper").

The Applicant also explained that the proposed combination lacks any motivation or suggestion to use propylene glycol in the claimed invention. Although the Examiner pointed to


Markusch as the source for the motivation, the Applicant explained that *Markusch* was directed toward the use of propylene glycol as a *foaming agent*, which is completely unnecessary and undesirable in the claimed invention. It is well settled that a prima facie case of obviousness requires that the motivation or suggestion be desirable, have some expectation of success, and not change the principle operation of the claimed invention. See MPEP § 2143.01. The suggestion in the prior art to use propylene glycol as a foaming agent is completely inapplicable to the present invention, not desirable, and would change the principle operation of the claimed invention.

With regard to the rejection of claims 7-12 and 14, *Bjorhaag* lacks the claimed agent for binding free water, *Sugano* motivates the use of a chelating agent as a stabilizer (not the claimed calcium salt), *Markusch* does not disclose calcium metasilicate, and *Randall* does not motivate the claimed phase change material. As a result, the proposed combinations clearly fail to support an obviousness rejection under 35 U.S.C. § 103 as they lack express claim elements and fail to provide the requisite motivation or suggestion to make the proposed combination.

In view of the foregoing amendments, the Examiner's reconsideration is requested and allowance of the present application is believed to be in order. If the Examiner believes a phone conference with Applicant's attorney would expedite prosecution of this application, she is respectfully requested to contact him at (315) 218-8515.

Respectfully submitted,

Dated: August 15, 2003

By: 
George R. McGuire
Reg. No. 36,603

BOND, SCHOENECK & KING, PLLC
One Lincoln Center
Syracuse, New York 13202-8530
(315)218-8515